UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,679	08/31/2001	Douglas J. Pearson	10017718-1	3775

7590 02/09/2005	EXAMINER
HEWLETT-PACKARD COMPANY	CHUONG, TRUC T
Intellectual Property Administration	

ART UNIT	PAPER NUMBER
2179	

HEWLETT-PACKARD COMPANY
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DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *21 January 2005*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-10 and 18-36* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-10 and 18-36* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail. Date _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This communication is responsive to RCE, filed 01/21/05.

2.   Claims 1-10, and 18-36 are pending in this application. Claims 1, 18, 27, and 34 are

independent claims. In the communication, all independent claims are amended, and claims 11-

17 are cancelled. This action is made non-final.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-10, and 18-36 are rejected under 35 U.S.C. 102(e) as being anticipated by

Miyahara et al. (U.S. Patent No. 6,314,213 B1).

        As to claim 1, Miyahara teaches a user interface configured to execute upon initiation of

a printing operation from a software application, the user interface comprising an actuatable icon

representing a shadow direction for an object to be rendered that when actuated actuates the

rendering of a shadow having the shadow direction from the rendered object when printed onto a

print media without applying the shadow to the object within the software application (setting

shadow directions for objects, images, or characters using the printer/copy/fax displayed panel,

or control from the computer screen, e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col.

17 lines 14-55, and figs. 13-14, 16-17).

As to claim 2, Miyahara teaches the user interface as defined in Claim 1, further

comprising an actuatable icon representing a shadow length for the rendered shadow that when

actuated actuates the rendered shadow having the shadow length (e.g., col. 15 line 40-col. 16 line

2, and figs. 16-17).

As to claim 3, Miyahara teaches the user interface as defined in Claim 1, wherein the

actuatable icon is a menu item on a menu (e.g., fig. 16).

As to claim 4, Miyahara teaches the user interface as defined in Claim 3, wherein the

menu item is a numerical expression (e.g., col. 14 lines 32-58, and figs. 13, 16-17).

As to claims 5, Miyahara teaches the user interface as defined in Claim 4, wherein the

numerical expression is includes one or more of degrees and radians (showing angle, radius, and

degree, etc. e.g., col. 14 lines 32-58, col. 15 lines 18-67, and figs. 13, 16-17).

As to claim 6, Miyahara teaches the user interface as defined in Claim 3, wherein the

menu item is a compass point direction (e.g., col. 14 lines 32-58, col. 15 lines 18-67, and figs.

13, 16-17).

As to claim 7, Miyahara teaches the user interface as defined in Claim 3, wherein the

rendered object having the shadow direction is rendered upon the menu (e.g., col. 14 lines 32-48,

col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17).

As to claim 8, Miyahara teaches the user interface as defined in Claim 7, further

comprising a print actuation icon that when actuated actuates the printing of shadowed objects

having the shadow direction (e.g., figs. 13-14, 16-17).

As to claim 9, Miyahara teaches the user interface as defined in Claim 8, wherein a word processor software application actuates the display of the menu (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17).

As to claim 10, Miyahara teaches the user interface as defined in Claim 7, wherein the printing operation is selected from the group consisting of printing (e.g., col. 17 lines 51-55, figs. 2-6), magnetic tape recording, photo imaging substrate recording, and magneto optical storage device writing.

As to claims 18-25, they are method claims of system claims 1, 2, 4-6, 8, 3, and 10. Note the rejections of claims 1, 2, 4-6, 8, 3, and 10 above respectively.

As to claim 26, it is a computer program product claim of method claim 18. Note the rejection of claim 18 above.

As to claim 27, Miyahara teaches a shadow rendering system comprising:

a display device (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, and figs. 3-6, 13-14, 16-17);

a host computer in electrical communication with the display device and in response to a print function (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17), performing a demand print application program including the steps of:

serving a user interface for display as a menu item on the menu, the icon representing a selection of a shadow direction for the predetermined object (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17); and

upon the actuation of said menu item:

executing an application program on the host computer to calculate a rendering of

a shadow having the appearance of being cast from the rendered predetermined object in

the selected shadow direction (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col.

17 lines 14-55, and figs. 13-14, 16-17); and

displaying the calculated shadow rendering as being cast from the rendered

predetermined object in the selected shadow direction (e.g., col. 14 lines 32-48, col. 15

line 40-col. 16 line 2, col. 17 lines 14-55, and figs. 13-14, 16-17).

As to claim 28, Miyahara teaches the system as defined in claim 27, wherein:

the shadow rendered by the application program executing on the host computer has a

default length (e.g., fig. 16); and

the demand print application program further includes the steps of:

displaying a second actuatable icon on the menu as a second menu item

representing a selectable shadow length for the rendered shadow (after the object has

been chosen the direction in fig. 16, the object will change in fig. 17 with different

directions, e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17 lines 14-55, and

figs. 13-14, 16-17); and

upon the actuation of said second menu item, said application program executing

on the host computer further performing the step of rendering the shadow having the

selected shadow length (e.g., col. 14 lines 32-48, col. 15 line 40-col. 16 line 2, col. 17

lines 14-55, and figs. 13-14, 16-17).

As to claims 29-33, they are similar in scope to claims 4-6, 8, and 10 above; therefore,

rejected under similar rationale.

As to claims 34-36, they are computer program product claims of system claims 1, 8, and

7. Note the rejections of claims 1, 8, and 7 above respectively.

Response to Arguments

5.   Applicant's arguments with respect to claims 1-36 have been considered but are moot in

view of the new ground(s) of rejection.

Conclusion

6.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Okahashi (U.S. Patent No. 5,799,108) teaches printer, shadow directions, GUI,

and actuated icons on a printer panel (cols. 2-22 and figs. 6-37B).

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Truc T Chuong whose telephone number is 571-272-4134. The

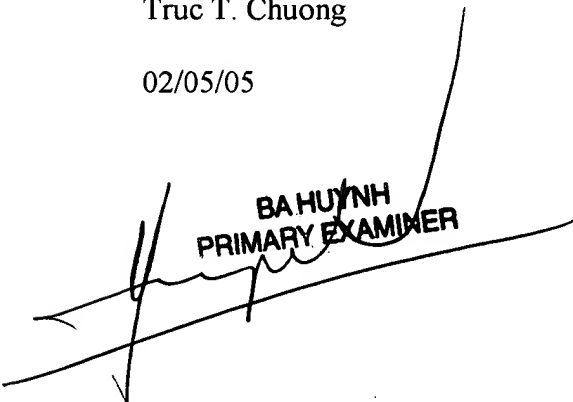examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Truc T. Chuong

02/05/05

BA HUYNH
PRIMARY EXAMINER